



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

ES

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/752,037 | 12/29/2000 | Frank Liebenow | 450.317US1 | 8768 |

24333 7590 09/22/2004

GATEWAY, INC.
ATTN: SCOTT CHARLES RICHARDSON
610 GATEWAY DRIVE
MAIL DROP Y-04
N. SIOUX CITY, SD 57049

EXAMINER

LE, KAREN L

ART UNIT PAPER NUMBER

2642

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,037

Applicant(s)

LIEBENOW, FRANK

Examiner

Karen Le

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-54 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's response filed on April 20, 2004. Claims 1-54, are now pending in the present application. **This action is made non-final.**

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7, 9-14, 18, 20-29, 31-39, 41, and 44-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Novak (U. S. 4,266,098).

Regarding claims 1, 9, 10, 20, 22-23 Novak teaches a method, a computer readable medium, of handling a call from a caller to a communication device, the method comprising:

Receiving the call (Col. 1, lines 49-50), determining if the communication device is in a privacy mode (Col. 1, lines 50-56), and if the communication device is in the privacy mode, completing the call if a privacy mode code is entered by the caller (Col. 2, lines 2-22).

If the communication device is in the privacy mode, providing a privacy mode message including a selected privacy override code to the caller (Col.1, lines 53-56).

Regarding claims 2, 11, 21, 24, 26, 33, and 38 Novak further teaches if the communication device is in the privacy mode, routing the call to a message system if no privacy mode code is entered by the caller (Col. 4, lines 31-32).

Art Unit: 2642

Regarding claims 3, 14, 29, and 34 Novak further teaches the privacy mode is selected by a user of the communication device (Col. 2, lines 57-61).

Regarding claims 7, 12-13, 18, and 41 Miller further teaches a privacy mode message selected by a user of the communication device (Col. 3, lines 1-3) and adapted to be provide to the caller prior to completing the call (Col. 1, lines 46-56) and the privacy mode code selected by the user of the communication device (Col. 2, lines 61-68).

Regarding claims 25, 31-32, 35-37 and 39 Novak further teaches a system for handling a call from a caller to a user of a communication device comprising:

a data entry device capable of receiving input to cause the communication device to enter a privacy mode, a memory capable of storing a privacy mode message, the privacy mode message including a selected privacy override code adapted to be provided to the caller prior to completing the call to the user, and a receiver capable of completing the call to the user if a privacy mode code is entered by the caller, a transmitter capable of completing the call to the user if the communication device is in the privacy mode and the privacy mode code is entered by the caller (Col. 1, lines 45- Col. 2, lines 15).

Regarding claim 27 Novak further teaches the data entry device is a telephone keypad (Col. 1, lines 58-63).

Regarding claims 28, Novak further teaches the privacy mode code comprises at least one keystroke from the data entry device (Col. 2, lines 1-6).

Regarding claims 44, Novak further teaches if the communication device is in the privacy mode, passing the call to a voice messaging system if the privacy mode code is not entered by

Art Unit: 2642

the caller, the voice messaging system being capable of recording a message spoken by the caller making the call (Col. 1, lines 46-56).

Regarding claims 45-48 Novak further teaches if the communication device is in the privacy mode, blocking completion of the call until the privacy mode code is entered. If the communication device is in the privacy mode preventing the communication device from producing an incoming call signal if the privacy mode code is not entered by the caller (Col. 1, lines 18-19 and 46-56).

Regarding claims 49 and 50 Novak further teaches establishing for the communications device a normal mode of operation and the privacy mode of operation. Normal mode of operation is characterized by producing an incoming call signal upon receipt of the call, and the privacy mode is characterized by producing the incoming call signal only if the caller has entered the privacy mode code (Col. 1, lines 13-15)

Regarding claims 51, Novak further teaches if the communication device is in the privacy mode, announcing the privacy mode code to the caller (Col. 1, lines 53-56).

Regarding claims 52, Novak further teaches the step of providing a privacy mode message including a selected privacy override code to the caller further comprises announcing the privacy code to the caller (Col. 1, lines 53-56).

Regarding claims 53, Novak further teaches the step of receiving a spoken command from a user of the communication device to place the communication device in the privacy mode.

Regarding claims 54, Novak further teaches if the communication device is in the privacy mode, preventing the communication device from producing an incoming call signal if the

Art Unit: 2642

privacy mode code is not entered by the caller while providing information regarding the incoming call through a display on the communication device (Col. 2, lines 47-52 and Col. 3, lines 13).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-6, 8,15-17, 19, 30, 40, 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak (U. S. 4,266,098) in view of Patsiokas et al. (U. S. 4,941,203).

Regarding claims 4, 15, 30, and 43 Novak does not teach communication device is one of a cellular telephone and personal digital assistant. However, Patsiokas teaches communication device is one of a cellular telephone and personal digital assistant (Abstract, lines 1-2). Patsiokas teaches call screening mode in a radio communication system includes a base station and a plurality of remote units. If caller enters an override code, the system establishes voice communication between the caller and the called remote unit. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Patsiokas' system to Novak's system to provide privacy mode in radio system.

Regarding claims 5 and 16 Novak does not teach the method is performed by one of a base station and a switch. However, Patsiokas teaches the method is performed by one of a base station and a switch (Col. 1, lines 45-51). Patsiokas teaches call screening mode in a radio communication system includes a base station and a plurality of remote units. If caller enters an override code, the system establishes voice communication between the caller and the called remote unit. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Patsiokas' system to Novak's system to provide privacy mode that is performed by one of a base station and a switch.

Regarding claims 6, 8, 17, 19, 40 and 42, Novak does not teach receiving a request from the communication device to place the communication device in the privacy and does not teach receiving a request from the communication device to place the communication device out of the privacy mode. However, Patsiokas teaches receiving a request from the communication device to place the communication device in the privacy and receiving a request from the communication device to place the communication device out of the privacy mode (Col. 1, lines 52-53). Patsiokas teaches a mean for selecting a particular communication or operating mode. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Patsiokas' system to Novak's system to provide a mean for selecting mode.

Response to Arguments

6. Applicant's arguments with respect to claims 1-54 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

Hand-delivered responses should be brought to

Crystal Park II, Sixth Floor (Receptionist)

2121 Crystal Drive

Arlington, VA 22202

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Le whose telephone number is 703-308-4998. The examiner can normally be reached on Monday - Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Application/Control Number: 09/752,037

Page 8

Art Unit: 2642

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Karen Le
KLL
September 16, 2004



AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700